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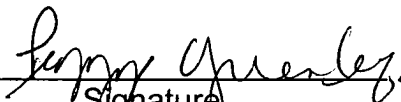


IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Mike O'Donnell and Andrew Cameron
Title: AUTOMATED LICENSING AND DELIVERY OF COPIES OF
WORKS OF AUTHORSHIP, WITH PROOF OF LICENSE
(twice amended)
Serial No.: 09/245,798
Filing Date: February 5, 1999
Examiner/Unit: Beth Van Doren / 2700
Attorney Docket No.: 1690-001-01

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REORGANIZED APPEAL BRIEF

In response to the Non-compliant appeal brief dated February 12, 2008, the Examiner requested that the Applicant change the organization of the appeal brief. This brief is organized as requested.

Real party in interest: The inventor, Mike O'Donnell, and an assignee US corporation of which he is an owner, iCopyright, Inc., which makes and uses in the US, and licenses others to make and use, embodiments of the invention.

Related appeals and interferences: None.

Status of claims: Claims 126 – 147 are pending in the application. All of them stand rejected under Section 103(a). There are three independent method claims, 126, 128, and 129, and three corresponding independent system claims, 138, 142, and 145.

Status of amendments: No amendment has been filed after the final rejection.

SUMMARY OF CLAIMED SUBJECT MATTER, with references to the specification by page and line number

Each independent claim is separately addressed:

Claim 129 specifies: A clearinghouse server system method for receiving from publishers of works of authorship offers of licenses, presenting the offers to potential licensees, acknowledging acceptances without intermediate human activity, and publishing on a publicly accessible network records of licenses granted, comprising:

(a) presenting on a publicly accessible computer network license offering registration web pages usable by a plurality of publishers to enter for each of a plurality of works of authorship information to identify the work and all terms for offering a license to make a use of the work;

(b) receiving on the registration web pages from a first computer and a second computer on the network information for a first registration record for a first work of authorship from a first publisher and for a second registration record for a second work of authorship from a second publisher;

(c) storing on the server system a first registration record and a second registration record, the data stored in the first registration record specifying an identifier

of the first work of authorship and all terms for offering to license the first work of authorship;

(d) receiving from a third computer on the network the identifier of the first work of authorship and, in response, presenting to the third computer a license offering web page incorporating all of the terms for offering a license to make a use of the first work of authorship;

(e) receiving from the third computer on the network a message indicating acceptance of the offered terms and responding to the third computer with a message that the acceptance has been received and acknowledged; and

(f) storing a record of the accepted license and making the record available for look-up by anyone from any computer on the publicly accessible network.

Support for claim 129 in the Specification (emphasis added):

Page 1 Line 8 “BACKGROUND OF THE INVENTION

“This invention addresses the problem of how to obtain licensing permission to use material created by another and how to present assurances that permission was obtained for the use.

...

Page 1 Line 30 “The Internet has presented serious challenges to the established copyright clearance systems. Many forms of works of authorship are now published digitally on the Internet, including text, audiowave recordings, digital music specifications, still images, and videos. When these works of authorship are received by a client computer on the Internet, a copy can very easily be made on the client computer. The copy can then be reproduced, distributed, performed, displayed, or used to prepare a derivative work. Although it is very easy to make such uses of source works of authorship, it is very difficult to find the owners of copyrights in these works or their agents and obtain licenses. Furthermore, even if the source work of authorship is used with permission, it is difficult for a person viewing the reproduced work, including the owner of copyrights in the source, to verify that the source was, in fact, used with permission without exceeding the scope of the license.

“Inventors have attempted to solve this problem by presenting technical means to prevent or discourage unauthorized use of works of authorship. These methods include using public key encryption to verify certificates of authority which are attached to works of authorship to prove that licenses have been obtained. They also

include various methods of applying watermarks to a digital work of authorship to trace the reuse of a work.

“SUMMARY OF THE INVENTION

“Rather than presenting technical barriers to unauthorized use or providing means to discover or prove unauthorized use, this invention makes it much easier to obtain licenses (or “clearances”) to use source material and to verify that the material has been used within the scope of the license. While some users will pirate materials given the opportunity, the vast majority will obtain a proper license if it can be done quickly and easily and they can easily prove to others that they obtained the proper license.

. . . .

Page 3 Line 13 “In another aspect, the invention is a method for granting licenses to use a work of authorship and publishing records of licenses granted. . . . The server of the licensing web page then automatically creates a license record associated with the license that has been granted. The license record is given a unique license identifier which can be used to find the license record on the network. The unique license identifier is then transmitted to the licensee for presentation with each licensed use of the source work of authorship. When the licensee publishes or otherwise uses the source material, the licensee presents the unique license identifier so that each recipient of the material can use the unique license identifier to access on the network the license record and determine the scope of the license that was granted.

. . . .

Page 4 Line 25 “When the licensee publishes or otherwise uses the source content, the licensee places an ICL tag on the licensee’s material. Like the PRC tag, the ICL tag is embedded in both machine readable form and human readable form. Selecting a hotspot associated with the machine readable tag will direct a user’s web browser to the license data record where the license information can be verified. The human readable ICL tag can be used to manually find the license data record by typing it into a browser.”

Claim 145 specifies: A clearinghouse server system that receives from publishers of works of authorship offers of licenses, presents the offers to potential licensees, acknowledges acceptances without intermediate human activity, and publishes on a publicly accessible network records of licenses granted, comprising:

(a) a registration web page server component that presents on a publicly accessible computer network license offering registration web pages usable by a plurality of publishers to enter for each of a plurality of works of authorship information to identify the work and all terms for offering a license to make a use of the work;

(b) a works registration component that receives on the registration web pages from a first computer and a second computer on the network information for a first registration record for a first work of authorship from a first publisher and for a second registration record for a second work of authorship from a second publisher;

(c) a database component that stores on the server system a first registration record and a second registration record, the data stored in the first registration record specifying an identifier of the first work of authorship and all terms for offering to license the first work of authorship;

(d) a license query web page server component that receives from a third computer on the network the identifier of the first work of authorship and, in response, presents to the third computer a license offering web page incorporating all of the terms for offering a license to make a use of the first work of authorship;

(e) an acceptance receiver component that receives from the third computer on the network a message indicating acceptance of the offered terms and responds to the third computer with a message that the acceptance has been received and acknowledged; and

(f) a proof of license web page server component that store a record of the accepted license and makes the record available for look-up by anyone from any computer on the publicly accessible network.

Support for claim 145 in the Specification (emphasis added):

Page 1 Line 8 “BACKGROUND OF THE INVENTION

“This invention addresses the problem of how to obtain licensing permission to use material created by another and how to present assurances that permission was obtained for the use.

...

Page 1 Line 30 “The Internet has presented serious challenges to the established copyright clearance systems. Many forms of works of authorship are now published digitally on the Internet, including text, audiowave recordings, digital music specifications, still images, and videos. When these works of authorship are received by a client computer on the Internet, a copy can very easily be made on the client computer. The copy can then be reproduced, distributed, performed, displayed, or used to prepare a

derivative work. Although it is very easy to make such uses of source works of authorship, it is very difficult to find the owners of copyrights in these works or their agents and obtain licenses. Furthermore, even if the source work of authorship is used with permission, it is difficult for a person viewing the reproduced work, including the owner of copyrights in the source, to verify that the source was, in fact, used with permission without exceeding the scope of the license.

"Inventors have attempted to solve this problem by presenting technical means to prevent or discourage unauthorized use of works of authorship. These methods include using public key encryption to verify certificates of authority which are attached to works of authorship to prove that licenses have been obtained. They also include various methods of applying watermarks to a digital work of authorship to trace the reuse of a work.

"SUMMARY OF THE INVENTION

"Rather than presenting technical barriers to unauthorized use or providing means to discover or prove unauthorized use, this invention makes it much easier to obtain licenses (or "clearances") to use source material and to verify that the material has been used within the scope of the license. While some users will pirate materials given the opportunity, the vast majority will obtain a proper license if it can be done quickly and easily and they can easily prove to others that they obtained the proper license.

Page 3 Line 13 "In another aspect, the invention is a method for granting licenses to use a work of authorship and publishing records of licenses granted. The server of the licensing web page then automatically creates a license record associated with the license that has been granted. The license record is given a unique license identifier which can be used to find the license record on the network. The unique license identifier is then transmitted to the licensee for presentation with each licensed use of the source work of authorship. When the licensee publishes or otherwise uses the source material, the licensee presents the unique license identifier so that each recipient of the material can use the unique license identifier to access on the network the license record and determine the scope of the license that was granted.

Page 4 Line 25 "When the licensee publishes or otherwise uses the source content, the licensee places an ICL tag on the licensee's material. Like the PRC tag, the ICL tag is embedded in both machine readable form and human readable form. Selecting a hotspot associated with the machine readable tag will direct a user's web browser to the license data record where the license information can be verified. The human readable ICL tag can be used to manually find the license data record by typing it into a browser."

Claim 126 specifies: A clearinghouse server system method for receiving from publishers of works of authorship offers of licenses, presenting the offers to potential licensees, and, in response to acceptances, without intermediate human activity, transmitting a copy of a work, comprising:

(a) presenting on a computer network license offering registration web pages usable by a plurality of publishers to enter for each of a plurality of works of authorship information to identify the work and all terms for offering a license to make a use of the work;

(b) receiving on the registration web pages from a first computer and a second computer on the network information for a first registration record for a first work of authorship from a first publisher and for a second registration record for a second work of authorship from a second publisher;

(c) storing on the server system a first registration record and a second registration record, the data stored in the first registration record specifying an identifier of the first work of authorship and all terms for offering to license the first work of authorship;

(d) receiving from a third computer on the network the identifier of the first work of authorship and, in response, presenting to the third computer a license offering web page incorporating all of the terms for offering a license to make a use of the first work of authorship; and

(e) receiving from the third computer on the network a message indicating acceptance of the offered terms and a request for an electronic copy, responding to the third computer with a message that the acceptance and request have been received and acknowledged, and, as a consequence of having received the message indicating acceptance of the offered terms and request for an electronic copy, sending to the third computer via the network an electronic copy of the first work of authorship.

Support for claim 126 in the Specification (emphasis added):

Page 6 Line 5

“DETAILED DESCRIPTION

....

Page 6 Line 16 When a user seeks clearance of a license to use a source work of authorship (an “article”) the system also provides a service to the user by providing the article either in preferred electronic format or professionally printed and mailed.

Consequently, there is a link 71 between the publisher subsystem 61 and the clearance and fulfillment subsystem 63. The link allows articles from an articles file 72 or from the network accessed via a URL from an articles URL file 73 to be communicated to the clearance and fulfillment subsystem for transmission to a user as identified in a user file 74 or for transmission to a fulfillment provider as identified in a fulfillment providers file 75.

Publishers, identified in the publisher’s file 76, can upload articles to the articles file 72, or article URLs to the article URLs file 73, along with article rules stored in an article rules file 77 and business rules for the licensing of each article stored in a business rules file 78.

Clearances may be sought by companies, which are identified in a companies file 81, as known via their contacts stored in the contacts file 82, or by users identified without companies stored in a users file 74. Their requests for clearances are stored in the clearance request file 83 and the granted clearances are stored in a clearances file 84. Similarly, fulfillments requested by users or companies are stored in a fulfillment request file 85 with details in a subfile 86. The fulfillment options which may be allowed for each granted clearance are stored in the fulfillment options file 87.

....

Page 12 Line 4 FIG. 6 shows the process followed by a user. When a user views on the Internet an item of content which is registered with the system 51 the user can click on a PRC tag 52 which directs the user’s web browser to a page of the iCopyright website which is customized for that publisher and that content. At the website, the user enters a name and password at step 53. From here, the user can go to step 54 or directly to step 58. The user enters information about himself, step 54, his affiliation and intended use, step 55, and his payment information, step 56. The user then accepts or declines the terms and conditions at step 57, and proceeds to state his intended use at step 58. The user then views the license or a summary of the license, step 59, and accepts or declines the license. If the license is accepted, the user proceeds to step 91

and receives confirmation and specifies any special instructions that are required to fulfill the user's request. In the case of Professional Reprints or other specialized document fulfillment requests, the user is fills out forms that collect the required job and document transmittal information. This could also include the use of special (publisher required or user requested) document packaging, encryption, digital watermarking or transmission techniques.

Claim 138 specifies: A clearinghouse server system that receives from publishers of works of authorship offers of licenses, presents the offers to potential licensees, and, in response to acceptances, without intermediate human activity, transmits a copy of a work, comprising:

(a) a registration web page server component that presents on a public network license offering registration web pages usable by a plurality of publishers to enter for each of a plurality of works of authorship information to identify the work and all terms for offering a license to make a use of the work;

(b) a works registration component that receives on the registration web pages from a first computer and a second computer on the network information for a first registration record for a first work of authorship from a first publisher and for a second registration record for a second work of authorship from a second publisher;

(c) a database component that stores on the server system a first registration record and a second registration record, the data stored in the first registration record specifying an identifier of the first work of authorship and all terms for offering to license the first work of authorship;

(d) a license query web page server component that receives from a third computer on the network the identifier of the first work of authorship and, in response, presents to the third computer a license offering web page incorporating all of the terms for offering a license to make a use of the first work of authorship; and

(e) an acceptance receiver and fulfillment component that receives from the third computer on the network a message indicating acceptance of the offered terms and a request for an electronic copy, responds to the third computer with a message that the

acceptance and request have been received and acknowledged, and, as a consequence of having received the message indicating acceptance of the offered terms and the request, sends to the third computer via the network an electronic copy of the first work of authorship.

Support for claim 138 in the Specification (emphasis added):

Page 6 Line 5

“DETAILED DESCRIPTION

. . . .

Page 6 Line 16 When a user seeks clearance of a license to use a source work of authorship (an “article”) the system also provides a service to the user by providing the article either in preferred electronic format or professionally printed and mailed.

Consequently, there is a link 71 between the publisher subsystem 61 and the clearance and fulfillment subsystem 63. The link allows articles from an articles file 72 or from the network accessed via a URL from an articles URL file 73 to be communicated to the clearance and fulfillment subsystem for transmission to a user as identified in a user file 74 or for transmission to a fulfillment provider as identified in a fulfillment providers file 75.

Publishers, identified in the publisher’s file 76, can upload articles to the articles file 72, or article URLs to the article URLs file 73, along with article rules stored in an article rules file 77 and business rules for the licensing of each article stored in a business rules file 78.

Clearances may be sought by companies, which are identified in a companies file 81, as known via their contacts stored in the contacts file 82, or by users identified without companies stored in a users file 74. Their requests for clearances are stored in the clearance request file 83 and the granted clearances are stored in a clearances file 84. Similarly, fulfillments requested by users or companies are stored in a fulfillment request file 85 with details in a subfile 86. The fulfillment options which may be allowed for each granted clearance are stored in the fulfillment options file 87.

. . . .

Page 12 Line 4 FIG. 6 shows the process followed by a user. When a user views on the Internet an item of content which is registered with the system 51 the user can click

on a PRC tag 52 which directs the user's web browser to a page of the iCopyright website which is customized for that publisher and that content. At the website, the user enters a name and password at step 53. From here, the user can go to step 54 or directly to step 58. The user enters information about himself, step 54, his affiliation and intended use, step 55, and his payment information, step 56. The user then accepts or declines the terms and conditions at step 57, and proceeds to state his intended use at step 58. The user then views the license or a summary of the license, step 59, and accepts or declines the license. If the license is accepted, the user proceeds to step 91 and receives confirmation and specifies any special instructions that are required to fulfill the user's request. In the case of Professional Reprints or other specialized document fulfillment requests, the user is fills out forms that collect the required job and document transmittal information. This could also include the use of special (publisher required or user requested) document packaging, encryption, digital watermarking or transmission techniques.

Claim 128 specifies: A clearinghouse server system method for receiving from publishers of works of authorship offers of licenses, presenting the offers to potential licensees, and, in response to acceptances, without intermediate human activity, printing a copy of a work, comprising:

(a) presenting, on a computer network, license offering registration web pages usable by a plurality of publishers to enter for each of a plurality of works of authorship information to identify the work and all terms for offering a license to make a use of the work;

(b) receiving on the registration web pages from a first computer and a second computer on the network information for a first registration record for a first work of authorship from a first publisher and for a second registration record for a second work of authorship from a second publisher;

(c) storing on the server system a first registration record and a second registration record, the data stored in the first registration record specifying an identifier of the first work of authorship and all terms for offering to license the first work of authorship;

(d) receiving from a third computer on the network the identifier of the first work of authorship and, in response, presenting to the third computer a license offering web page incorporating all of the terms for offering a license to make a use of the first work of authorship;

(e) receiving from the third computer on the network a message indicating acceptance of the offered terms and requesting that a paper reprint be delivered, responding to the third computer with a message that the acceptance and request have been received and acknowledged, and

(f) after the message indicating acceptance and reprint request is received, as a consequence of having received the acceptance and request, the clearinghouse server system sending to a printer a copy of the work of authorship for printing on paper and delivery.

Support for claim 128 in the Specification (emphasis added):

Page 6 Line 5

“DETAILED DESCRIPTION

. . . .

Page 6 Line 16 When a user seeks clearance of a license to use a source work of authorship (an “article”) the system also provides a service to the user by providing the article either in preferred electronic format or professionally printed and mailed.

Consequently, there is a link 71 between the publisher subsystem 61 and the clearance and fulfillment subsystem 63. The link allows articles from an articles file 72 or from the network accessed via a URL from an articles URL file 73 to be communicated to the clearance and fulfillment subsystem for transmission to a user as identified in a user file 74 or for transmission to a fulfillment provider as identified in a fulfillment providers file 75.

Publishers, identified in the publisher’s file 76, can upload articles to the articles file 72, or article URLs to the article URLs file 73, along with article rules stored in an article rules file 77 and business rules for the licensing of each article stored in a business rules file 78.

Clearances may be sought by companies, which are identified in a companies file 81, as known via their contacts stored in the contacts file 82, or by users identified without

companies stored in a users file 74. Their requests for clearances are stored in the clearance request file 83 and the granted clearances are stored in a clearances file 84. Similarly, fulfillments requested by users or companies are stored in a fulfillment request file 85 with details in a subfile 86. The fulfillment options which may be allowed for each granted clearance are stored in the fulfillment options file 87.

...
Page 12 Line 4 FIG. 6 shows the process followed by a user. When a user views on the Internet an item of content which is registered with the system 51 the user can click on a PRC tag 52 which directs the user's web browser to a page of the iCopyright website which is customized for that publisher and that content. At the website, the user enters a name and password at step 53. From here, the user can go to step 54 or directly to step 58. The user enters information about himself, step 54, his affiliation and intended use, step 55, and his payment information, step 56. The user then accepts or declines the terms and conditions at step 57, and proceeds to state his intended use at step 58. The user then views the license or a summary of the license, step 59, and accepts or declines the license. If the license is accepted, the user proceeds to step 91 and receives confirmation and specifies any special instructions that are required to fulfill the user's request. In the case of Professional Reprints or other specialized document fulfillment requests, the user is fills out forms that collect the required job and document transmittal information. This could also include the use of special (publisher required or user requested) document packaging, encryption, digital watermarking or transmission techniques.

Claim 142 specifies: A clearinghouse server system that receives from publishers of works of authorship offers of licenses, presents the offers to potential licensees, and, in response to acceptances, without intermediate human activity, prints a copy of a work for delivery to a licensee, comprising:

(a) a registration web page server component that presents on a public network license offering registration web pages usable by a plurality of publishers to enter for each of a plurality of works of authorship information to identify the work and all terms for offering a license to make a use of the work;

(b) a works registration component that receives on the registration web pages from a first computer and a second computer on the network information for a first registration record for a first work of authorship from a first publisher and for a second registration record for a second work of authorship from a second publisher;

(c) a database component that stores on the server system a first registration record and a second registration record, the data stored in the first registration record specifying an identifier of the first work of authorship and all terms for offering to license the first work of authorship;

(d) a license query web page server component that receives from a third computer on the network the identifier of the first work of authorship and, in response, presenting to the third computer a license offering web page incorporating all of the terms for offering a license to make a use of the first work of authorship;

(e) an acceptance receiver and fulfillment component that receives from the third computer on the network a message indicating acceptance of the offered terms and a request for a paper reprint, responds to the third computer with a message that the acceptance and request have been received and acknowledged, and, after the message indicating acceptance is received and as a consequence of having received the acceptance, sends to a printer a copy of the work of authorship for printing on paper and delivery.

Support in the Specification for claim 142 (emphasis added):

Page 6 Line 5 “DETAILED DESCRIPTION

...

Page 6 Line 16 When a user seeks clearance of a license to use a source work of authorship (an “article”) the system also provides a service to the user by providing the article either in preferred electronic format or professionally printed and mailed.

Consequently, there is a link 71 between the publisher subsystem 61 and the clearance and fulfillment subsystem 63. The link allows articles from an articles file 72 or from the network accessed via a URL from an articles URL file 73 to be communicated to the

clearance and fulfillment subsystem for transmission to a user as identified in a user file 74 or for transmission to a fulfillment provider as identified in a fulfillment providers file 75.

Publishers, identified in the publisher's file 76, can upload articles to the articles file 72, or article URLs to the article URLs file 73, along with article rules stored in an article rules file 77 and business rules for the licensing of each article stored in a business rules file 78.

Clearances may be sought by companies, which are identified in a companies file 81, as known via their contacts stored in the contacts file 82, or by users identified without companies stored in a users file 74. Their requests for clearances are stored in the clearance request file 83 and the granted clearances are stored in a clearances file 84. Similarly, fulfillments requested by users or companies are stored in a fulfillment request file 85 with details in a subfile 86. The fulfillment options which may be allowed for each granted clearance are stored in the fulfillment options file 87.

Page 12 Line 4 FIG. 6 shows the process followed by a user. When a user views on the Internet an item of content which is registered with the system 51 the user can click on a PRC tag 52 which directs the user's web browser to a page of the iCopyright website which is customized for that publisher and that content. At the website, the user enters a name and password at step 53. From here, the user can go to step 54 or directly to step 58. The user enters information about himself, step 54, his affiliation and intended use, step 55, and his payment information, step 56. The user then accepts or declines the terms and conditions at step 57, and proceeds to state his intended use at step 58. The user then views the license or a summary of the license, step 59, and accepts or declines the license. If the license is accepted, the user proceeds to step 91 and receives confirmation and specifies any special instructions that are required to fulfill the user's request. In the case of Professional Reprints or other specialized document fulfillment requests, the user is fills out forms that collect the required job and document transmittal information. This could also include the use of special (publisher required or user requested) document packaging, encryption, digital watermarking or transmission techniques.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Claims 129 and 145: The Examiner rejects claims 129 and 145 under §103(a) as obvious in view of a single reference, Johnson, US 5,991,876.

Claims 126 and 138: The Examiner rejects claims 126 and 138 under §103(a) as obvious in view of a single reference, Johnson, US 5,991,876.

Claims 128 and 142: The Examiner rejects claims 128 and 142 under §103(a) as obvious over Johnson, US 5,991,876 in view of Elsevier Science (www.elsevier.com).

ARGUMENTS

Claims 129 and 145:

The issue for these claims is focused on whether a method or system with the last element is obvious. The last element is:

“making the record available for look-up by anyone from any computer on the publicly accessible network.”

In the final office action, the Examiner asserts that this element is obvious because “Johnson et al discloses a publicly accessible network and storing a record of the accepted license and making the record available for look-up from a computer on the publicly accessible network”. It is true that Johnson teaches making the record available for look up by persons with certain management authorization, but Johnson does not teach making it accessible “by anyone”. Johnson explicitly teaches away from making it accessible by anyone.

The Examiner maintains that, because Johnson teaches “that potential licensees are allowed access to the system,” it is therefore obvious that anyone might be allowed access to all the records of what licenses have been granted and to whom. This does not follow. Just because all people are allowed access to some parts of the system and only administrators are allowed access to the records of what licenses were granted and to whom, it is not obvious that ALL people should be allowed access to the records of WHAT LICENSES WERE GRANTED AND TO WHOM. Johnson teaches that only administrators should have access to these records.

All web sites that are accessible on a network have some components that are accessible to more people and some components that are accessible to fewer people. There is no web site where all components have the same degree of availability to all. These differences are generally established by adjusting "security settings." For example, for most web sites, only the site administrator or the host operator can delete files, and there are typically some files for the web site that even the site administrator can not delete and can not fully erase by writing over each spot on the hard disk where the data was stored, this function being limited to the host operator. As a more relevant example for the present issue, the site administrator usually has the power to revise any data that is presented on the site and others usually have very limited power or no power to revise data that is presented on the site. It is also common that a site will allow the world to view certain data collected at the site and allow only the site administrator to view other data collected at the site, such as number of site visits or IP addresses of visitors.

In Johnson, only the site administrator is allowed to view records of who had obtained a license to use a work of authorship. This information is not made available to the general public. The question that the applicant and the Examiner are grappling with is whether making this information available to the general public is obvious. Although this change from the prior art can easily be made by a programmer, this does not answer the question of whether it was obvious to do so.

The body of the application quoted above articulates extensively that making this information available to the general public is non-obvious and is an important invention over the then prior art relating to controlling uses of copyright protected works of authorship.

As described in quoted sections of the application above, the invented method is a solution to the problem of easy unauthorized copying of works of authorship that is completely different from the prior art solutions to this problem. Johnson does not even attempt to address this problem. There is nothing in the prior art, especially not in Johnson, which suggests this solution to the problem or motivates this solution to the problem. The prior art solutions of technical copy restriction and watermarking and the like all teach away from this solution. In contrast to the prior art technical solutions, the

invention exploits the fact that humans are social animals and care what other people think of them when their actions are published for anyone to check on.

There is no teaching in Johnson that provides a suggestion or motivation to make the change to the Johnson system suggested by the Examiner. The examiner points out that "potential licensees" are allowed to access certain data in the system. However, they are not allowed to access "a record of the accepted license" as specified by the last element of claims 129 and 145. The fact that they are members of the general public and are allowed access to some data does not make it obvious that they should be allowed access to other data to which only administrators are allowed access as taught by Johnson.

Thus, the examiner has not made a prima facie case of obviousness. Independent method claim 129 and the corresponding system claim 145 should be allowed, along with the claims that depend from them.

Claims 126 and 138:

Independent method claim 126 and its corresponding system form claim 138 are rejected under §103 as unpatentable over Johnson (US 5,991,876).

With respect to the point of novelty of claim 128, the Examiner is misreading Johnson. Johnson does not teach or suggest that a person could place an order for a "copy" of a work of authorship. The only deliverables for which a person might place an order, as taught by Johnson, are "rights". The "rights" that may be ordered in the system taught by Johnson are so intangible that they have no embodiments. There is no "copy" of any right that may be ordered. The "right" is actually a legal release by a copyright holder in favor of the person to whom the right is granted, so that the licensee can not be successfully sued by the copyright holder for infringement of copyrights, provided certain limitations on the "right" are followed.

Johnson makes clear that the only properties offered by the system are rights and not copies. In column 3, Johnson states: "A second enhancement is the inclusion of an order table to provide a dynamic log of right authorizations and denials." (Emphasis added) In column 8 lines 15 - 20 Johnson states "during the first year of the contract, rights are offered at a base fee During the second year of the contract, rights are offered at a base fee of"

Details of the ordering capabilities of the system are discussed in column 9 beginning at line 35 where Johnson states that the order table “provides a dynamic log of right authorizations and denials”. At lines 45 - 48 Johnson states: “Order_right field 448 contains a reference or link to a right_instance field 410 of rights table 408. This link identifies the right ordered.” (Emphasis added)

In column 10 at lines 42 - 45, Johnson states “User interface 700 includes a view of a constructive index card 702 to specify a particular right for which authorization is sought.” (Emphasis added)

Applicant respectfully submits that the Examiner is repeatedly misreading Johnson. In particular, where the Examiner states on page 9: “See figure 7, column 7, lines 1-10 and 40-55, column 9, lines 35-55, column 10, lines 40-60”, none of these passages, when read carefully, supports the Examiner’s view. Each of these passages refers to a “right” and not a copy of a work of authorship.

Figure 7 does not teach that the system may offer, or a user may receive “a copy of the work of authorship”. Figure 7 teaches that, when a prospective licensee requests a license, the licensee may be required to specify whether the type of use will be on paper or electronic and the number of copies that the licensee wishes to make. The fact that a user is requested to state what kind of use the user will make of the rights obtained does not imply that the server can send a copy of a work of authorship. Figure 7 does not teach that a user of the server system may place an order for a copy to be delivered, in any form, or that the server system is capable of delivering a copy in any form.

In column 7 at lines 1 - 10 Johnson states that the types of works for which copyrights might be licensed and managed by the system include works that may be embodied in electronic copies. However, Johnson says nothing about delivering electronic copies of those works to licensees.

In column 7 at lines 40 - 55, Johnson explains that the type of use for which a prospective licensee may seek permission may be specified, such as: educational, not for profit, commercial, on paper, in an optical memory, in a computer memory serving an intranet, or in a computer memory serving the internet. This paragraph in Johnson does not teach either that a prospective licensee can place an order for a copy of a work of authorship or that the system could be made capable of delivering a copy of a work of authorship.

In column 9 at lines 35 - 55, Johnson states that the right ordered might be the right to make electronic copies of the work. However, Johnson says nothing about allowing the licensee access to an electronic copy of the work to make these copies. This paragraph of Johnson merely teaches that “rights” can be ordered, not that copies can be ordered or that the system has the ability to deliver the work upon acceptance of the license.

In column 10 at lines 40 - 60, Johnson discusses the user interface through which a prospective licensee will place an order for rights. When the prospective licensee places the order, the licensee may be required to specify whether the use will be made on paper or electronically and the number of copies that the user will make. This paragraph of Johnson does not teach either that the prospective licensee may place an order for copies or that the server system can deliver copies.

Thus, Johnson does not teach or suggest that a person could request or receive a “copy” of a work of authorship. Although each person in Johnson who orders a “right” relating to a work of authorship (in contrast to other kinds of property with which the system in Johnson is also designed to work) must have a copy of the work of authorship (or the original) to exercise that right, Johnson does not address how the person might get such a copy. Presumably, they already have a copy -- otherwise they would not know that they want a right to make copies or other copyright restricted uses of it. Element (e) of claim 126 specifies that a copy of the work of authorship is not provided across the network until after the user has accepted the terms of an offered license.

Even if one were to assume that a person who needs source materials to exercise the right they bought might, in some cases, be able download those materials from a site on the World Wide Web, Johnson does not suggest or imply that the materials might be delivered “as a consequence of” the person having indicated “acceptance of the offered terms and request for an electronic copy”. This is the crux of the matter.

The question then is whether it is obvious that the system of Johnson might be improved to add a feature that, once a customer buys a right to use materials by accessing a server across a network, the server will then offer a chance to request that a copy be sent across the network and, if the customer requests such a copy, it is automatically sent to the customer across the network.

Under US patent law, some improvements are patentable and some improvements are obvious and therefore not patentable. The Applicant submits that, if it were obvious to make the claimed improvement to the system of Johnson, it would have been done between the date the Johnson application was filed in 1996 and the date the present application was filed three years later. This is a field in which there was intense inventive activity during those years.

The Johnson patent application discloses inventions made by the Copyright Clearance Center (CCC). In 1996, when the Johnson application was filed, the CCC did not maintain a computer system for providing copies of works of authorship across the Internet to general public licensees. The CCC provided (and still provides) a service to publishers to help them grant licenses ("rights") to use their published works of authorship. The publishers published their works in various forms including electronic. Members of the public who saw or received a reference to one of those works could then go to the CCC to obtain a license to make a use of the work that was otherwise prohibited by copyright law. The licensees obtained their source materials directly or indirectly from the publishers, not from CCC.

Thus, neither the system then publicly disclosed by CCC nor the system taught by Johnson is sufficient to implement the invention. A link is required to a database that contains copies of the works of authorship in question. Such a link is not suggested by Johnson. The Johnson system does not store the work itself or even have a link with access to a database containing such works. A prospective licensee has to access the Johnson system and enter the title of the work or the author's name in order to locate the licensing rules for the work. If the prospective licensee decides to license the content based on the stated rules, they pay the administrator of the Johnson system. There is no stated mechanism for how a copy of the licensed content might be delivered to the licensee. The assumption is that the user already has a copy of the work and is simply paying for rights to copy it or otherwise do something with it other than merely read it. It is not obvious from Johnson to provide these functions because the repository only stores rights information about the work, it does not store the work itself.

To make a prima facie case that an improvement over Johnson is obvious, the Examiner must point to a teaching, suggestion, or motivation in the reference itself or in the knowledge generally available to one of ordinary skill in the art that the improvement

should be made to the prior art system. The claimed concept may seem obvious now, but it was not obvious when the present patent application was filed in 1999, particularly for a system "usable by a plurality of publishers" as specified by element (a) of claim 126. Applicant submits that the present inventor was the first to invent the claimed method of automatically doing so upon request as part of a transaction to secure the rights and that this is a significant invention.

Claims 126 and 138 are therefore allowable.

Claims 128 and 142:

Claims 128 and 142 stand rejected under §103 as unpatentable over Johnson (US 5,991,876) in view of a reference (Elsevier) showing that a service of a human providing paper reprints of works of authorship in response to a request posted via a computer network was in the prior art. There are many such references that could be cited for this proposition.

The essential question is whether it was obvious to modify this service to be performed automatically, without human intermediation, and combine it with a server for granting reprint licenses such that the request for a license and the request for a paper copy could be submitted in a single session on the server and, as a consequence, an electronic copy of the work would then automatically be sent by the server system to a printer for printing on paper and delivery.

To address this question, Applicant begins by noting, as did the Examiner, that a combination of Johnson with the Elsevier service, or any similar service, would not produce the claimed invention because neither reference teaches that an electronic copy might automatically be sent to a printer without a link of human assistance.

In 1996 when the Johnson application was filed, the CCC did not maintain a computer system that was capable of sending copies of works of authorship to a printer for printing reprints. Thus, neither the system then used by CCC nor the system taught by Johnson is sufficient to implement the invention. In addition, a link is required to a database that contains printable copies of the works of authorship in question. Such a link is not suggested by Johnson or Elsevier.

The Examiner asserts that Johnson teaches "the third computer/client requests the order of paper copies be supplied," citing figure 7, column 7 lines 40 - 55, column 8

lines 1 - 22, column 9 lines 35 - 55, and column 10 lines 40 – 60. This is not correct. All of these parts of Johnson have been discussed above with respect to this issue except for the column 8 reference.

In column 8 at lines 1 - 22 Johnson discusses the rights table which holds information about rights granted. Again, the granting of a right is not the delivery of a copy. It is not the delivery of anything. Although the price to be paid by the prospective licensee as discussed in this paragraph of Johnson may vary according to the number of copies that the licensee is authorized to make, this section of Johnson does not teach that the prospective licensee may place an order for someone else to make the copies or that the server system may provide copies.

The Examiner argues her reading of Johnson is supported by the fact that Johnson mentions that educational institutions make copies of documents to create course packets. This fact reported by Johnson does not support the Examiner's position. It does not suggest or teach that the clearinghouse server system should allow users to place orders for copies of works authorship or that the server system should deliver ordered copies of works of authorship.

Claims 128 and 142 are therefore allowable.

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Claims appendix:

Claims 1 - 125. (canceled)

126. A clearinghouse server system method for receiving from publishers of works of authorship offers of licenses, presenting the offers to potential licensees, and, in response to acceptances, without intermediate human activity, transmitting a copy of a work, comprising:

(a) presenting on a computer network license offering registration web pages usable by a plurality of publishers to enter for each of a plurality of works of authorship information to identify the work and all terms for offering a license to make a use of the work;

(b) receiving on the registration web pages from a first computer and a second computer on the network information for a first registration record for a first work of authorship from a first publisher and for a second registration record for a second work of authorship from a second publisher;

(c) storing on the server system a first registration record and a second registration record, the data stored in the first registration record specifying an identifier of the first work of authorship and all terms for offering to license the first work of authorship;

(d) receiving from a third computer on the network the identifier of the first work of authorship and, in response, presenting to the third computer a license offering web page incorporating all of the terms for offering a license to make a use of the first work of authorship; and

(e) receiving from the third computer on the network a message indicating acceptance of the offered terms and a request for an electronic copy, responding to the third computer with a message that the acceptance and request have been received and acknowledged, and, as a consequence of having received the message indicating

acceptance of the offered terms and request for an electronic copy, sending to the third computer via the network an electronic copy of the first work of authorship.

127. (previously presented) The method of claim 126 wherein the electronic copy includes electronically coded text.

128. A clearinghouse server system method for receiving from publishers of works of authorship offers of licenses, presenting the offers to potential licensees, and, in response to acceptances, without intermediate human activity, printing a copy of a work, comprising:

(a) presenting, on a computer network, license offering registration web pages usable by a plurality of publishers to enter for each of a plurality of works of authorship information to identify the work and all terms for offering a license to make a use of the work;

(b) receiving on the registration web pages from a first computer and a second computer on the network information for a first registration record for a first work of authorship from a first publisher and for a second registration record for a second work of authorship from a second publisher;

(c) storing on the server system a first registration record and a second registration record, the data stored in the first registration record specifying an identifier of the first work of authorship and all terms for offering to license the first work of authorship;

(d) receiving from a third computer on the network the identifier of the first work of authorship and, in response, presenting to the third computer a license offering web page incorporating all of the terms for offering a license to make a use of the first work of authorship;

(e) receiving from the third computer on the network a message indicating acceptance of the offered terms and requesting that a paper reprint be delivered,

responding to the third computer with a message that the acceptance and request have been received and acknowledged, and

(f) after the message indicating acceptance and reprint request is received, as a consequence of having received the acceptance and request, the clearinghouse server system sending to a printer a copy of the work of authorship for printing on paper and delivery.

129. A clearinghouse server system method for receiving from publishers of works of authorship offers of licenses, presenting the offers to potential licensees, acknowledging acceptances without intermediate human activity, and publishing on a publicly accessible network records of licenses granted, comprising:

(a) presenting on a publicly accessible computer network license offering registration web pages usable by a plurality of publishers to enter for each of a plurality of works of authorship information to identify the work and all terms for offering a license to make a use of the work;

(b) receiving on the registration web pages from a first computer and a second computer on the network information for a first registration record for a first work of authorship from a first publisher and for a second registration record for a second work of authorship from a second publisher;

(c) storing on the server system a first registration record and a second registration record, the data stored in the first registration record specifying an identifier of the first work of authorship and all terms for offering to license the first work of authorship;

(d) receiving from a third computer on the network the identifier of the first work of authorship and, in response, presenting to the third computer a license offering web page incorporating all of the terms for offering a license to make a use of the first work of authorship;

(e) receiving from the third computer on the network a message indicating acceptance of the offered terms and responding to the third computer with a message that the acceptance has been received and acknowledged; and

(f) storing a record of the accepted license and making the record available for look-up by anyone from any computer on the publicly accessible network.

130. The method of claim 129 wherein the step of presenting license offering registration web pages is performed in a first server in the server system and the step of presenting to the third computer a licensing web page is performed in a second server in the server system.

131. The method of claim 129 wherein functions of the server system are distributed across a plurality of physical computers and at least one of the server system steps is performed in the first computer.

132. The method of claim 129 further comprising publishing from a server on the network the first work of authorship in which the identifier of the first work of authorship is embedded such that, when the first work of authorship is displayed on the third computer and a user of the third computer clicks on a hot spot in the work of authorship, the embedded identifier is used to form a network address that links the third computer to the license offering web page for the first work of authorship.

133 The method of claim 126 wherein the electronic copy includes a human readable message indicating that the copy was made with permission of an owner of copyrights in the first work of authorship.

134. The method of claim 126 wherein the electronic copy includes a network address of a web page containing an indication verifying that the copy was made with permission of an owner of copyrights in the first work of authorship.

135. The method of claim 134 wherein the electronic copy includes a hotspot that, when selected by a user when the electronic copy is displayed on a computer

display, causes a browser program to send a retrieve request to the network address of the web page containing a message verifying that the copy was made with permission of an owner of copyrights in the first work of authorship.

136. The method of claim 128 wherein the copy sent to a printer includes a human readable message indicating that the copy was made with permission of an owner of copyrights in the first work of authorship.

137. The method of claim 136 wherein the message includes a network address of a web page containing an indication verifying that the copy was made with permission of an owner of copyrights in the first work of authorship.

138. A clearinghouse server system that receives from publishers of works of authorship offers of licenses, presents the offers to potential licensees, and, in response to acceptances, without intermediate human activity, transmits a copy of a work, comprising:

(a) a registration web page server component that presents on a public network license offering registration web pages usable by a plurality of publishers to enter for each of a plurality of works of authorship information to identify the work and all terms for offering a license to make a use of the work;

(b) a works registration component that receives on the registration web pages from a first computer and a second computer on the network information for a first registration record for a first work of authorship from a first publisher and for a second registration record for a second work of authorship from a second publisher;

(c) a database component that stores on the server system a first registration record and a second registration record, the data stored in the first registration record specifying an identifier of the first work of authorship and all terms for offering to license the first work of authorship;

(d) a license query web page server component that receives from a third computer on the network the identifier of the first work of authorship and, in response,

presents to the third computer a license offering web page incorporating all of the terms for offering a license to make a use of the first work of authorship; and

(e) an acceptance receiver and fulfillment component that receives from the third computer on the network a message indicating acceptance of the offered terms and a request for an electronic copy, responds to the third computer with a message that the acceptance and request have been received and acknowledged, and, as a consequence of having received the message indicating acceptance of the offered terms and the request, sends to the third computer via the network an electronic copy of the first work of authorship.

139. The system of claim 138 wherein the electronic copy includes a human readable message indicating that the copy was made with permission of an owner of copyrights in the first work of authorship.

140. The system of claim 138 wherein the electronic copy includes a network address of a web page containing an indication verifying that the copy was made with permission of an owner of copyrights in the first work of authorship.

141. The system of claim 140 wherein the electronic copy includes a hotspot that, when selected by a user when the electronic copy is displayed on a computer display, causes a browser program to send a retrieve request to the network address of the web page containing a message verifying that the copy was made with permission of an owner of copyrights in the first work of authorship.

142. A clearinghouse server system that receives from publishers of works of authorship offers of licenses, presents the offers to potential licensees, and, in response to acceptances, without intermediate human activity, prints a copy of a work for delivery to a licensee, comprising:

(a) a registration web page server component that presents on a public network license offering registration web pages usable by a plurality of publishers to enter for

each of a plurality of works of authorship information to identify the work and all terms for offering a license to make a use of the work;

(b) a works registration component that receives on the registration web pages from a first computer and a second computer on the network information for a first registration record for a first work of authorship from a first publisher and for a second registration record for a second work of authorship from a second publisher;

(c) a database component that stores on the server system a first registration record and a second registration record, the data stored in the first registration record specifying an identifier of the first work of authorship and all terms for offering to license the first work of authorship;

(d) a license query web page server component that receives from a third computer on the network the identifier of the first work of authorship and, in response, presenting to the third computer a license offering web page incorporating all of the terms for offering a license to make a use of the first work of authorship;

(e) an acceptance receiver and fulfillment component that receives from the third computer on the network a message indicating acceptance of the offered terms and a request for a paper reprint, responds to the third computer with a message that the acceptance and request have been received and acknowledged, and, after the message indicating acceptance is received and as a consequence of having received the acceptance, sends to a printer a copy of the work of authorship for printing on paper and delivery.

143. The system of claim 142 wherein the copy sent to a printer includes a human readable message indicating that the copy was made with permission of an owner of copyrights in the first work of authorship.

144. The system of claim 143 wherein the message includes a network address of a web page containing an indication verifying that the copy was made with permission of an owner of copyrights in the first work of authorship.

145. A clearinghouse server system that receives from publishers of works of authorship offers of licenses, presents the offers to potential licensees, acknowledges acceptances without intermediate human activity, and publishes on a publicly accessible network records of licenses granted, comprising:

(a) a registration web page server component that presents on a publicly accessible computer network license offering registration web pages usable by a plurality of publishers to enter for each of a plurality of works of authorship information to identify the work and all terms for offering a license to make a use of the work;

(b) a works registration component that receives on the registration web pages from a first computer and a second computer on the network information for a first registration record for a first work of authorship from a first publisher and for a second registration record for a second work of authorship from a second publisher;

(c) a database component that stores on the server system a first registration record and a second registration record, the data stored in the first registration record specifying an identifier of the first work of authorship and all terms for offering to license the first work of authorship;

(d) a license query web page server component that receives from a third computer on the network the identifier of the first work of authorship and, in response, presents to the third computer a license offering web page incorporating all of the terms for offering a license to make a use of the first work of authorship;

(e) an acceptance receiver component that receives from the third computer on the network a message indicating acceptance of the offered terms and responds to the third computer with a message that the acceptance has been received and acknowledged; and

(f) a proof of license web page server component that store a record of the accepted license and makes the record available for look-up by anyone from any computer on the publicly accessible network.

146. The method of claim 128 wherein the copy sent to a printer includes a human readable message indicating a name of the publisher of the first work of authorship.

147. The system of claim 142 wherein the copy sent to a printer includes a human readable message indicating a name of the publisher of the first work of authorship.

Evidence appendix: None

Related proceedings appendix: None.